

6.



UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/698,077	10/30/00	WILLS	K 08250.0045-0

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.
1300 I STREET, N. W.
WASHINGTON DC 20005-3315

TM02/0829

EXAMINER

HAVAN, T

ART UNIT	PAPER NUMBER
----------	--------------

2672

DATE MAILED:

08/29/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

10

Office Action Summary

Application No.

09/698,077

Applicant(s)

WILLS, KENNETH

Examiner

Thu-Thao Havan

Art Unit

2672

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 January 1999.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Drawings

This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 17-40 are rejected under the judicially created doctrine of double patenting over claims 1-33 of U. S. Patent No. 6,202,065 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: Claims 17-40 of the instant application are

Art Unit: 2672

substantial duplicate of claims 1-33 of patent number 6,202,065. When two claims are duplicates and they both cover the same thing, it is improper to make the invention distinguish.

Re claims 17, 23, 32, and 35, claims 1 and 2 of patent 6,202,065 claims an information search and retrieval process using geographical coordinates, which process comprises building an index of coordinates for a plurality of text based references, resources or sties, each having a set of the coordinates (col. 7 and 8).

Re claims 29 and 38, claims 4-5, 9-10, and 21-22 of patent 6,202,065 claims retrieving the identified object(s); wherein the retrieving step includes determining a geometric shape encompassing a plurality of sets of graphic coordinates corresponding to geographical coordinates defined by the geometric shape (col. 8-12).

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Art Unit: 2672

Claims 17-18, 20, 23-24, 26-27, and 32-37 are rejected under 35 U.S.C. 102(b) as being unpatentable by Fushimi et al. (US patent no. 5,475,598).

1. As to claims 17, 23, 32, and 35, the prior art Fushimi had:

A.) A method for searching and retrieving information comprising receiving/sending a request identifying a first site, and range data defining a distance from the first site (**fig. 1, 9, 12a, 13a, and 14a**). In figure 12a, Fushimi discloses the departure point and the destination point of the site then calculates the ranges between the two locations. He teaches a user requests a particular departure and destination location then his system calculates the optimum distance for each road map.

B.) The step of selecting/receiving trip planning information selected based on the identified site and the range data (**fig. 2c, 11c, 13a, and 13c**). In figure 13, Fushimi teaches the trip planning information by providing different alternative routes for each site and its ranges data in distance from a particular departure point to a particular destination point.

C.) The step of outputting the selected trip planning information (**fig. 13c**). Fushimi discloses the result of the routes in figure 13c. Each distance of the departure and destination route is calculated and displayed for the user.

2. As to claims 18 and 24, Fushimi discloses the trip planning information includes information identifying a location of interest within a proximity of the first site derived from the range data (**fig. 2a, 8a, 11a, and 13a**). In figure 8a, Fushimi discloses the trip planning information by identifying the departure point and the destination point and the ranges for site.

Art Unit: 2672

3. As to claims 20, 26-27, 33-34, and 36-37, Fushimi discloses the request further includes a second site, and wherein the trip planning information includes information identifying a location of interest associated with the second site (**fig. 2c and 8a-8b**). In figure 8a, Fushimi discloses the five sites that the users can choose to drive for their trip.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 19, 21-22, 25, and 28-30, and 38-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fushimi et al. (US patent no. 5,475,598) in view of Tenmoku et al. (US patent no. 5,486,822).

4. As to claims 29 and 38, the prior art Fushimi had:

A.) A method for searching and retrieving information, comprising receiving/sending a request identifying at least a first site, a second site and a type of location of interest (**fig. 8a-8c, 11b11c, and 13c**). In figure 13c, Fushimi discloses the eleven different sites and paths the users can choose with eleven different locations of interest.

B.) The step of receiving information associated with the first and second sites and selected based on the type of location of interest and selected using a geometric shape generated

Art Unit: 2672

based on the first and second sites (**fig. 8a-8c, 11b11c, 13a, and 13c**). The information is displayed for the users and there are links that associated with each sites.

However, Fushimi fails to explicitly teach the geometric shape. Nevertheless, the different sites are in geometric shapes because geometric shapes include straight lines, circles, or squares. In figure 13a, Fushimi discloses the geometric shapes of the routes. Furthermore, both Fushimi and Tenmoku teach the road map route for the users to choose. Tenmoku focuses more on the different destinations that the users can choose by disclosing the routes in geometric shapes in his diagrams. In figures 1-2b and 5-7, Tenmoku discloses the routes in geometric shapes. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the geometric shapes because Tenmoku teaches different directions for the road map of a vehicle navigation system in geometric shapes (**fig. 1-2b and 5-7**).

5. As to claims 19, 21-22, 25, 28, 30, and 39, Tenmoku discloses the trip planning information includes information identifying services available within a proximity of the first site derived from the range data (**col. 5, lines 7-13; fig. 5 and 6**). The road map memory of Tenmoku discloses background information such as famous facilities, which include services. Furthermore, the users have many different sites and routes to choose for their journey.

6. As to claims 31 and 40, Fushimi discloses the geometric shape is generated based on a first distance value representing the distance between the first and second sites, and a second distance value representing a function performed on the first distance value (**fig. 8a**). In figure 8a, Fushimi discloses the different distances for each

Art Unit: 2672

route that the users can choose to drive. Each N represents the different paths that the users can drive.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Uekawa et al., US Patent No. 5,845,228

Nimura et al., US Patent No. 5,231,584

Lamoure, US Patent No. 5,329,108

Wills, US Patent No. 5,893,093

Wills, US Patent No. 6,202,065

Inquiries

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thu-Thao Havan whose telephone number is (703) 308-7062. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Razavi can be reached on (703) 305-4713. The fax phone numbers for the organization where this application or proceeding is assigned are (703)308-5359 for regular communications and (703)308-5359 for After Final communications.

Art Unit: 2672

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-9500.

Wayne
WAYNE AMSBURY
PRIMARY PATENT EXAMINER

Thu-Thao Havan

August 22, 2001